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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,991	08/01/2003	Herbert L. Berman	MEDO-P001CONT	8976

7590 10/04/2006  
Fernandez & Associates, LLP  
PO Box D  
Menlo Park, CA 94026-6402

EXAMINER
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WINAKUR, ERIC FRANK

ART UNIT	PAPER NUMBER
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3768

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/632,991	BERMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric F. Winakur	3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-44 is/are pending in the application.
- 4a) Of the above claim(s) 37-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Species A in the reply filed on 6 September 2006 is acknowledged.
2. Claims 37 - 44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6 September 2006.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 32, it is unclear if Applicant intends the "analyte measurement generator" to be an element of the previously claimed "non-invasive analyte monitor" provided in the base claim, or if Applicant intends to claim a second measuring element.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 29 - 31 and 34 - 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Mault. Mault teaches an integrated calorie management system that includes an oxygen sensor 40 (non-invasive analyte monitor), and activity sensor 60, and a computing device 52. Data can be wirelessly transmitted and computed results are displayed for the subject. See Figures 3 - 6, 15, and 16 and the descriptions thereof.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 29, 30, and 34 - 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen et al. '020 (USPN 5,840,020) in view of Heinonen et al. '586 (USPN 5,772,586). Heinonen '020 teaches a patient monitoring system that includes a mobile phone that may include an integrated communication and measuring device that can communicate a subject's glucose measurement and data related to the subject's diet, medication, and physical strain to a processing location that includes a mathematical model for predicting the subject's glucose level at a future time. Further, the computed data is transmitted to the subject's mobile phone which outputs the results for the subject's use. Heinonen '020 teach all of the features of the claimed

invention except that the measuring device is a non-invasive monitor. Heinonen '586 teach a system related to the Heinonen '020 invention that includes an integrated mobile phone and measuring device, wherein the measuring device can be a non-invasive device (column 5, lines 14 - 20). It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Heinonen '020 with a non-invasive measuring device, since Heinonen '020 requires a measuring device in their system and Heinonen '586 teaches that a non-invasive measuring device may be included in such a system.

9. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen '020 and Heinonen '586 as applied to claim 29 above, and further in view of Rosenthal. The combination teaches that data related to a subject's glucose level is supplied from the subject's device to the data processing system for incorporation in the mathematical model, but do not teach particular details of the non-invasive glucose measurement system. Rosenthal teaches a non-invasive glucose sensor that performs measurements through a subject's finger when placed on the skin and further provides details related to calibration of the sensor. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a non-invasive glucose sensor as taught by Rosenthal in the combination, since the combination requires a non-invasive sensor of conventional design, and Rosenthal teaches one such sensor.

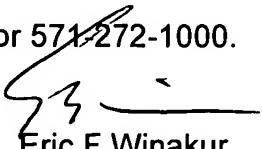
**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Porumbescu teaches a metabolic control arrangement, similar to that of Mault.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric F. Winakur whose telephone number is 571/272-4736. The examiner can normally be reached on M-Th, 7:30-5; alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571/272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Eric F Winakur  
Primary Examiner  
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